



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,828	08/31/1998	ANDERS BERKENSTAM	10806-65	4054

7590 12/20/2001

HOLLY D KOZLOWSKI  
DINSMORE & SHOHL  
1900 CHEMED CENTER  
255 EAST FIFTH STREET  
CINCINNATI, OH 45202

EXAMINER

PAK, MICHAEL D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 12/20/2001

65

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/143,828	Applicant(s) Berkenstam et al.
Examiner Michael Pak	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Oct 3, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-9, 13-17, 29-31, 33, and 42-55 is/are pending in the application.

4a) Of the above, claim(s) 29-31 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9, 13-17, 33, and 42-55 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

**DETAILED ACTION**

**Response to Amendment**

1. Applicant's response to office action filed 21 January 2001 (Paper No. 13) has been received.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Applicant's arguments filed 21 January 2001 (Paper No. 13), have been fully considered but they are not found persuasive.

***Double Patenting***

4. Claims 146-160 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-11 and 23 of U.S. Patent No. 5,739,307 in view of Barde et al. (US Patent 5,229,500).

The reasons for the rejection was set forth in the last office action.

Applicants wish to defer addressing this issue until such time as the instant claims are allowable. The claims remain rejected until such time.

5. Claims 146, 149, 150, and 154 are provisionally rejected under the judicially created doctrine of obviousness-type double

09/143828  
Serial Number: 09/219,952  
Art Unit: 1646

2

patenting as being unpatentable over claims 14, 36, 39 and 40 of copending Application No. 09/220,617 in view of Barde et al. (US Patent 5,229,500).

The reasons for the rejection was set forth in the last office action.

Applicants argue that copending application 09/220,617 discloses persephin which is roughly 40% percent identity and not 65%. However, the claims are drawn to generic persephin which encompasses the percent identity higher than 40%.

***Claim Rejections - 35 USC § 102***

6. Claims 146, 149, 150 and 154 are rejected under 35 U.S.C. 102(b) as being anticipated by Barde et al. (US Patent 5,229,500).

The reasons for the rejection was set forth in the last office action.

Applicants argue that Barde et al. does not disclose growth factor with 65% identity with SEQ ID NO:31. However, the CHO cell inherently make the neurturin growth factor.

Applicants argue that extrinsic evidence is required. Kotzbauer et al. (Nature, 1996) teach that DG44CHO cell inherently secret the Neurturin growth factor.

Applicants argue that Barde et al. would not have recognized that a cell secreted neurturin. However, the method claims are

09/14/3828  
Serial Number: 09/219,952  
Art Unit: 1646

3

generic and are drawn to method which is taught by Barde et al.

7. No claims are allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 308-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:20 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyer, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

09/143828  
Serial Number: ~~09/219,952~~  
Art Unit: 1646

4

*Michael D. Pak*  
Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
30 November 2001